

REMARKS

Claims 1 and 4-12 remain pending after this response.

Status of Claims

The Office Action cover sheet inadvertently indicates that claims 1-12 are rejected, when in fact only claims 1-2 and 4-12 are pending (claim 3 having been previously cancelled).

Rejection under 35 USC 103(a)

Claims 1-2 and 4-12 stand rejected under 35 USC 103(a) as being unpatentable over Torigoshi JP '528 (see pages 3-5 of the outstanding Office Action). This rejection is respectfully traversed.

By way of review, in the claimed invention the elastic members each have (a) a portion contributory to elastic extensibility and contractibility in each of the regions *outside* the lateral sides of the patterned sheet, *and* (b) a portion substantially *non*-contributory to elastic extensibility and contractibility in the region *inside* the lateral sides of the patterned sheet.

Further, as can be seen from Figure 3 in applicants' specification, the elastic members **24** in front and back portions **A** and **B**, respectively, are a continuation of elastic members **23**. However, the elastic members **24** reside in the portion **F** (the middle portion between lateral portions **E**). The present invention thus has "the portion substantially non-contributory to elastic extensibility and contractibility [is] disposed between the patterned sheet and the inner sheet" (see the location of feature (b) as recited in claim 1). Also, the elastic members **24** in portion **F**

of the present invention either are cut or are present as fragments (see Fig. 3), as also recited in claim 1.

In addition, the elastic members of the present invention reside between the patterned sheet and the inner sheet. This can be seen from Figure 3, where sheet **21** is the outer sheet and sheet **22** is the inner sheet. These structural features allow a picture or pictorial pattern to be clearly seen from the outside.

The claimed invention is neither disclosed nor suggested by the cited prior art.

In contrast to the present invention and the claimed features thereof, Torigoshi '528 fails to disclose the elastic members and location thereof as instantly claimed.

For example, Torigoshi '528 fails to teach or suggest that the limitations of cancelled claim 3 (which now reside in claim 1) – i.e., wherein the portion substantially non-contributory to elastic extensibility and contractibility are cut ends or a fragment or both resulting from cutting the elastic members. Instead, Torigoshi '528 only discloses the structure of a diaper, and does not disclose the recited method of producing same. Therefore, the reference fails to teach or suggest that the portion which is non-contributory to elastic extensibility and contractability is formed by cutting, when the elastic members are not arranged at the central portion of the absorbent member, and are arranged at the right and left side portions of the absorbent member. For this reason, it is difficult to determine from the teachings of the reference whether the cut ends are “a portion non-contributory to elastic extensibility and contractability” consistent with the cut ends of applicants' claimed invention.

It is noted that Torigoshi '528 discloses at paragraph [0259] that the design sheet 100 can be interposed between the external sheets consistent with the claimed invention. Elastic members

are arranged between the external sheets. The Examiner takes the position that it is obvious to arrange a patterned sheet at the outer side of the elastic members as occurs in the claimed invention. However, as mentioned above, Torigoshi '528 fails to disclose whether or not there is "a portion non-contributory to elastic extensibility and contractability" in the cut ends of the elastic members, or the portion where the elastic members exist. Consequently, Torigoshi '528 neither discloses nor suggests that a patterned sheet is disposed at the outer side of the elastic members.

The reference seeks to provide a disposable diaper having a neat appearance around the leg portions with fringes of leg portions which are not fluttering. Thus, the intent is not to show a pattern in such a manner that it can be clearly seen through from the outside, as in the claimed invention.

For instance, applicants note that elastic members in the present invention reside between the patterned sheet and the inner sheet. Further, as can be seen from Figure 3, sheet **21** is the outer sheet and sheet **22** is the inner sheet. These structural features allow a picture or pictorial pattern to be clearly seen from the outside. Such features are not disclosed in Torigoshi '528. It is not even clear or clearly disclosed in Torigoshi '528 if its pictorial pattern (e.g., a picture of a dog) is clearly seen from an outside point of view.

Accordingly, applicants respectfully submit that the cited modification of Torigoshi '528 still fails to disclose all instantly claimed features and a *prima facie* case of obviousness has not been established. A proper obviousness inquiry requires consideration of three factors: (1) the prior art reference (or references when combined) must teach or suggest all the claim limitations; (2) whether or not the prior art would have taught, motivated, or suggested to those of ordinary

skill in the art that they should make the claimed invention (or practice the invention in case of a claimed method or process); and (3) whether the prior art establishes that in making the claimed invention (or practicing the invention in case of a claimed method or process), there would have been a reasonable expectation of success. *See In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991); *see also In re Kotzab*, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000); *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). In this regard, not even the initial requirement of disclosure of all claimed features has been satisfied.

For instance, the cited modification of Torigoshi '528 does not result in a patterned sheet having a pattern is disposed between the outer sheet and the inner sheet as instantly claimed.

Applicants add that the requisite motivation as well as the reasonable expectation of success are lacking. With regard to the required level of motivation, the location of the portion that is substantially non-contributory to elastic extensibility and contractibility aids in bringing about a pictorial pattern clearly seen from the outside of the absorbent article. Such a feature or description is missing in the cited Torigoshi '528 reference.

With regard to the requisite reasonable expectation of success, Torigoshi '528 merely discloses a picture on its diaper in Figure 1. Therefore, applicants respectfully submit that such a generic description does not lead one of ordinary skill in the art to experiment enough such that the claimed invention could be achieved. In this regard, applicants respectfully submit that it is not *prima facie* obvious to modify a reference unless the reference suggests an advantage to be gained from the modification. *See In re Sernaker*, 217 USPQ 1, 6 (Fed. Cir. 1983). That suggestion is missing in Torigoshi '528. Thus, applicants respectfully submit that the required level of reasonable expectation of success is lacking.

Regarding the lack of disclosure in Torigoshi '528 for the claimed total transmittance value as recited in pending claim 2, applicants respectfully traverse the Examiner's position since this feature is a not matter of optimization. The Examiner has not provided any scientific or technical evidence to show that this feature of, e.g., pending claim 2, is a matter of routine skill in the art. Applicants also traverse the conclusions of optimization and the application of the *In re Boesch* decision as stated at page 4 of the Office Action. This is because: "The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention on any ground is always upon the examiner." *Ex parte Parks*, 30 USPQ2d 1234, 1236 (citing *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992)); *see also In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984). Here, since no literature or evidence has been provided to show that, e.g., opacity is a matter of optimization, the burden has not shifted back to applicants to prove otherwise.

Based on the above, applicants respectfully submit that a *prima facie* case of obviousness has not been established (e.g., no disclosure of all claimed features; requisite reasonable expectation of success is missing).


Accordingly, applicants respectfully request reconsideration, withdrawal of this rejection and allowance of the currently pending claims.

The application is believed to be in condition for allowance. An early indication of same is earnestly solicited.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

 Dated:

Respectfully submitted,

By 
John W. Bailey
Registration No.: 32,881
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road, Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant